

REMARKS

Upon entry of this paper, claims 1-10, 12-38, and 43 are pending in this application.

Applicants have proposed to amend claims 1, 4, 12-14, 17, 25-29, 33, 34, and 38, and have canceled claim 11 herein (claims 39-42 and 44 were previously canceled). The changes proposed herein would not introduce any new matter.

Applicant respectfully requests reconsideration of the rejection of claims 1-3, 9, 11-16, 22, 24-30, 33-35, 38, and 43 under 35 U.S.C. § 102(b) as being anticipated by *Ishii et al.* (U.S. Patent No. 5,982,416) (as noted above, claim 11 has been canceled herein). As will be explained below, the *Ishii et al.* reference does not disclose each and every feature specified in independent claims 1, 12-14, 25-29, 33, 34, and 38, as presented herein.

Considering first independent claim 1, the claimed subject matter specified in this claim is directed toward an image data generating device. This device outputs control data that designates output conditions for each of a plurality of output devices together with a corresponding piece of image data from an imaging device to each output device. This claimed feature is technically significant because 1) it is necessary to use the input device to designate the output conditions of the output devices, so that the output devices reproduce an image under the shooting conditions specified in the input device, and 2) different output devices have different output characteristics and, therefore, the output conditions need to be specified individually for each of the output devices.

The *Ishii et al.* reference relates to a color matching technique, which is characterized by transmitting the so-called ICC profile type of information together with image data from an imaging device to a host computer. The claimed subject matter is significantly different from that shown in the *Ishii et al.* reference. In particular, the *Ishii et al.* reference relates image data to only one profile data, and the *Ishii et al.* reference neither discloses nor suggests the concept of relating image data to multiple output devices as in the claimed subject matter.

In support of the anticipation rejection, the Examiner refers to profile storage unit 15 shown in Figure 1 of the *Ishii et al.* reference. The profile storage unit 15 stores multiple profiles associated with output devices; however, these profiles are merely the ones that are previously stored in host computer 10. As such, there is no disclosure in the *Ishii et al.* reference that an input device outputs profile data regarding an output device.

Applicant's proposed amendments to claim 1 distinguish the claimed image data generating device from a host computer as shown in the *Ishii et al.* reference. In particular, the claimed image generating device is now defined as a device that outputs image data and output control data to, e.g., a host computer. Further, the output control data feature has been amended to specify that the output control data reflects at least an image reproduction property and, consequently, this feature is now distinguished from the profile disclosed in the *Ishii et al.* reference.

In summary, the image data generating device specified in claim 1, as presented herein, generates image data, acquires output control data, and outputs image data associated with the output control data. For at least the foregoing reasons, the host computer disclosed in the *Ishii et al.* reference does not include each and every feature specified in claim 1.

Turning to the other independent claims included in the anticipation rejection, namely claims 12-14, 25-29, 33, 34, and 38, Applicant has proposed to amend these claims along the lines discussed above with regard to claim 1. Applicant respectfully submits that the arguments set forth above regarding claim 1 apply equally to the other independent claims included in the anticipation rejection because these claims specify the same or similar features, albeit in different contexts, e.g., independent claims 12, 28, and 38 define a computer-executable program and independent claims 14, 27, and 34 define a method for generating image data to be outputted by an output device. Accordingly, for at least the foregoing reasons, independent claims 1, 12-14, 25-29, 33, 34, and 38 are patentable under 35

U.S.C. § 102(b) over *Ishii et al.* Claims 2, 3, 9, and 43, each of which depends from claim 1, claims 15, 16, 22, and 24, each of which depends from claim 14, claim 30, which depends from claim 29, and claim 35, which depends from claim 34, are likewise patentable under 35 U.S.C. § 102(b) over *Ishii et al.* for at least the same reasons set forth regarding the applicable independent claim.

Applicant respectfully requests reconsideration of the rejection of claims 4-8, 10, 17-21, 23, 31, 32, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Ishii et al.* in view of *Kohler et al.* (U.S. Patent No. 5,646,752). Each of the claims included in this obviousness rejection depends from one of the independent claims that has been rejected under 35 U.S.C. § 102(b) as being anticipated by *Ishii et al.* The *Kohler et al.* reference has been cited by the Examiner merely to show the feature of identifying a classification selected from a group of classifications, and does not cure the above-discussed deficiencies of the *Ishii et al.* reference relative to the claimed subject matter. Further, similar to the *Ishii et al.* reference, the *Kohler et al.* reference also discloses a color management-related technique. Applicant respectfully submits that the *Kohler et al.* reference provides no disclosure of the image generating device providing information about the output device classification. The portion of the *Kohler et al.* reference cited by the Examiner (column 9, lines 11-19) describes conformity to the ICC profile, and states only that “DeviceModel” defines the model number or name of the device with which the profile is to be used (if the target is an input device, the name of the input device is defined, and if the target is an output device, the name of the output device is defined). Accordingly, claims 4-8, 10, 17-21, 23, 31, 32, 36, and 37 are patentable under 35 U.S.C. § 103(a) over *Ishii et al.* in view of *Kohler et al.* for at least the reason that they ultimately depend from one of independent claims 1, 14, 29, and 34, as well as for the reason set forth just above.

Applicant respectfully requests that the amendments proposed herein be entered. The proposed amendments respond to the Examiner's position that Applicant's arguments regarding the *Ishii et al.* reference do not coincide with the claim language, and could not have been presented earlier because the Examiner's position was raised for the first time in the Final Office Action. Moreover, the proposed amendments do not raise any new issues or require any additional search. Accordingly, Applicant respectfully submits that the proposed amendments comply with the requirements of 37 C.F.R. § 1.116(b) and should be entered.

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of claims 1-10, 12-38, and 43, as presented herein, and submits that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP003).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.



Peter B. Martine
Reg. No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
Customer Number 25920